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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,289	08/08/2005	Wolfgang Otto Budde	DE 030047	1503

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EXAMINER

ABYANEH, ALI S

ART UNIT	PAPER NUMBER
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2437

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07/21/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/522,289	Applicant(s) BUDDE ET AL.	
	Examiner ALI S. ABYANEH	Art Unit 2437	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06-23-2009 has been entered.
2. Claims 1-15 are pending.
3. Claims 1, 14 and 15 are amended.

Response to Arguments

4. Applicant's amendments/arguments filed on 05-22-2009 have been fully considered but they are not persuasive.

In page 6 of the remarks applicant argues "the cited portions of Svensson fail to disclose or suggest a first portable unit (1) comprising: a memory (3) for storing a worldwide unambiguous key record (4), a first transmitter (6) provided for the short range information transmission of the key record (4) to at least one apparatus (2) of the network during a configuration stage to be stored in said at least one apparatus". Examiner respectfully disagrees. Svensson teaches a communication device 12 (portable unit) with a key programmed therein (storing key record) (see paragraph 19). Communication device 12 includes a second interface 24 (first transmitter) for a short

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range communication with a device 18 (apparatus 2) (see paragraph 13). Svensson also discloses communication device 12 transmitting key to the device 18 (see paragraph 24, lines 17-19 wherein discloses “transmitting the user’s key from the communication device 12 to the computing device 18 across the BLUETOOTH link 24”).

In response to applicant's argument in page 7, lines 7-19 of the remarks that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., “unlike Svensson, the first portable unit is not a device with processing capabilities ...[r]ather, the first portable unit is a storage item, akin to an RFID tag ...the first portable unit is only needed during the configuration...”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In view of the above discussion examiner maintains the rejection as follows:

Objections

5. Claims 3, 6 and 10 are objected to for minor informalities:

in claim 3, after “claim 1,” delete the second occurrence of “,”.

In claim 6, there is insufficient antecedent basis for limitation of “the guest key”.

Claim 10 includes “erasing-the guest key”, delete the “-“ after “erasing”.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claim 1-15 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-4 and 6-26 of copending Application No. 10/521719. Claims 1-4 and 6-26 of Application 10/521719 contain every element of claims 1-15 of the instant application and as such anticipate claims 1-15 of the instant application. Although the conflicting claims are not identical, they are not patentably distinct from each other.

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"A later patent claim is not patentably distinct from an earlier patent claim if the 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Svensson (US Pub No. 2003/0120920 A1) in view of Varadharajan (EP 0756397 A2).

Regarding claim 1, 14 and 15

Svensson teaches a security system for networks, comprising a first portable unit comprising:

a memory for storing a worldwide unambiguous key record, a first transmitter provided for short-range information transmission of the key record to at least one apparatus of the network during a configuration stage,

said at least one apparatus of the network comprising:

a receiving unit comprising: a receiving for receiving the key record from the first portable unit via said short rang transmission during the said configuration stage to allow secure communication with at least one other apparatus of the network during an authentication stage; an evaluation component of the apparatus for, storing, processing and/or passing on the key record or a part of the key record (paragraph [0024]-[0025]).

Svensson does not explicitly teach **storing the key record** in said at least one apparatus, storing, processing and/or passing on the key record or a part of the key record **to a second component of the at least one apparatus during the said authentication stage; and means for triggering a transmission of the key record via transmitter**. However, in an analogous art, Varadharajan teaches storing the key record in said at least one apparatus, storing, processing and/or passing on the key record or a part of the key record to a second component of the at least one apparatus (column 6, lines 20-26); and means for triggering a transmission of the key record via transmitter (column 3, lines 25-34).

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Svensson to include storing the key record in said at least one apparatus, storing, processing and/or passing on the key record or a part of the key record to a second component of the at least one apparatus; and means

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for triggering a transmission of the key record via transmitter. This would have been obvious because person having ordinary skill in the art at the time the invention was made would have been motivated to do so in order to allow authentication and to protect communication between devices (column 1, lines 8-10).

Regarding claim 2-5

Varadharajan furthermore teaches wherein the first portable unit further comprises a triggering unit for triggering a short-range transmission of the key record to said at least one apparatus of the network; wherein upon a user's approach to the receiving unit, a detector unit in the portable unit is provided for triggering the short-range information transmission of the key record to said at least one apparatus of the network; wherein a key generator is provided in the first unit or in a second unit for generating a sequence of guest key records; and wherein the first portable unit is configured to transmit a guest key record upon activation of a second triggering unit (column 3, lines 1-10 and 25-34).

Regarding claim 6 and 7

Svensson furthermore teaches a security system wherein the key record and the guest key record each consist of a bit sequence (paragraph [0020]); wherein the portable first unit is a part of an apparatus, particularly a remote control unit (paragraph [0025]).

Regarding claim 8 and 9

Svensson furthermore teaches a security system, wherein the key record is supplied by the first portable unit during or before a network configuration, particularly an automatic network configuration, of an apparatus; and wherein the key record and the guest key record comprise characterizing bits which are provided for distinguishing between key records and other bit sequences and characterize bit sequences as key record or as guest key record (paragraph [0020]).

Regarding claim 10 and 11

Svensson furthermore teaches a security system, wherein the apparatus is provided for erasing-the guest key record; and a security system, wherein the apparatus is provided for authentication and encryption of useful data to be transmitted between the apparatuses of the network by means of a key comprised in the key record (paragraph [0024]-[0025]).

Regarding claim 12 and 13

Svensson furthermore teaches a security system, wherein the apparatus is a powerline communication apparatus; and a powerline communication network (paragraph [0012]).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ali Abyaneh whose telephone number is (571) 272-7961. The examiner can normally be reached on Monday-Friday from (8:00-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on **(571) 272-3865**. The fax phone numbers for the organization where this application or proceeding is assigned as (571) 273-8300 Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/A. S. A./

Examiner, Art Unit 2437

/Emmanuel L. Moise/

Supervisory Patent Examiner, Art Unit 2437